

PTO/SB/ 26 (10-96)

**TERMINAL DISCLAIMER TO OBVIATE DOUBLE
PATENTING REJECTIONS OVER PRIOR PATENT**Docket No.
11899.0195.DVUS01 (MOBT:195-1)In re Application of: David A. Fischhoff, Roy L. Fuchs, Paul B. Lavrik, Sylvia A. McPherson, and
Frederick J. Perlak

Application No.: 09/943,692

Filed: August 31, 2001

For: COLEOPTERAN TOXIN PROTEINS OF *BACILLUS THURINGIENSIS* (Amended)

Petitioner, **MONSANTO TECHNOLOGY LLC**, is sole owner of an undivided 100 percent interest in the application identified above and U.S. Patent No. 5,495,071. Petitioner hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 to 156 and 173 on patent U.S. Patent No. 5,495,071 that issued on February 27, 1996. Petitioners hereby agree that any patent so granted on the instant application shall be enforceable only for and during such period that it and the issued patent are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, petitioners do not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. §§ 154 to 156 and 173 of the issued second patent, in the event that any such issued patent: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. § 1.321, has all claims canceled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term.

Pursuant to 37 C.F.R. § 3.73, the undersigned has reviewed the evidentiary assignment documents and certifies that, to the best of his knowledge and belief, the titles of the instant application and of U.S. Patent No. 5,495,071 are in the name of **MONSANTO TECHNOLOGY LLC**.

For submissions on behalf of an organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned (whose title is supplied below) is empowered to act on behalf of the organization.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

MONSANTO TECHNOLOGY LLCDate: 30 Jun 04By: [Signature]

Thomas P. McBride

Title: Intellectual Property Counsel

⊗ Terminal disclaimer fee under 37 C.F.R. § 1.20(d) should be charged to Deposit Account No. 01-2508/11899.0195.DVUS01.

⊗ PTO suggested wording for terminal disclaimer was:



unchanged.



changed (if changed, an explanation should be supplied).

Paragraph in bold added to denote compliance with 37 C.F.R. § 3.73

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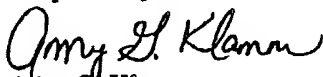
VI. Rejections under the judicially created doctrine of obviousness-type double patenting over U.S. Patent No. 5,495,071.

Claims 37-38, 40-42, and 53-56 stand rejected under the judicially created doctrine of obviousness-type double patenting over claims 19-20 of U.S. Patent No. 5,495,071. Applicants are herein filing a terminal disclaimer to obviate the double patenting rejection as it applies to pending claims 53-56.

Applicants believe that the remaining claims are in condition for allowance, and respectfully request that they be allowed. The Examiner is encouraged to call the undersigned should any further action be required for allowance.

It is believed that no fees are due at this time. However, should any fees under 37 C.F.R. §§ 1.16 to 1.21 be required for any reason relating to the enclosed materials, the Commissioner is authorized to deduct said fees from Deposit Account No. 01-2508/11899.0195.DVUS01.

Respectfully submitted,



Amy G. Klann

Reg. No. 48,155

Agent for Assignee,

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Date: July 2, 2004